

REMARKS

Claims 1-27 are pending in the present application. Claims 1-12 have been withdrawn. Claim 26 was objected to due to informalities. Claims 17, 20 and 22-27 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 13, 14, 21-25 and 27 were rejected under 35 U.S.C. §102 as being anticipated by Carter et al., U.S. Patent No. 5,771,904. Claims 15-20 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carter et al. in view of EP 0491289.

Claims 13, 16, 17 and 19-27 have been amended. New claims 28-32 have been added.

Objection to Claim 26

Claim 26 was objected to due to informalities. Claim 26 has now been amended to recite "positions of objectives of the microscope" and thereby remove the antecedent basis problem regarding "positions of the objectives" pointed out by the Examiner.

Withdrawal of the objection to claim 26 due to informalities is respectfully requested.

Rejection under 35 U.S.C. §112 to claims 17, 20 and 22-27

Claims 17, 20 and 22-27 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 13 has now been amended to recite "the reference specimen including at least one planar area" and now provides proper antecedent basis for the "the at least one planar area" recitations now present in claims 17, 20 and 27. Claim 27 has also been amended to recite "objective or objectives of the microscope" and thereby remove the antecedent basis problem pointed out by the Examiner. Claims 22 and 23 have now been amended for clarity by deleting the recitation "conclusions are drawn..." and including a recitation to certain information being "determined". Claim 26 has now been amended for clarity by deleting the recitation "in particular their path length differences". New claim 28 has been added including the "path length differences" recitation.

It is respectfully submitted that claims 17, 20 and 22-27 are now clear and definite. Withdrawal of the rejection to these claims under 35 U.S.C. §112, second paragraph, is

respectfully requested.

Rejection under 35 U.S.C. §102 to claims 13, 14, 21-25 and 27

Claims 13, 14, 21-25 and 27 were rejected under 35 U.S.C. §102 as being anticipated by Carter et al., U.S. Patent No. 5,771,904.

Carter et al. describes film measurement system in which a reference sample 90 may be used to provide a wavelength marker for calibration of the system. An absorption or a fluorescence peak or valley or interference pattern provided by the reference sample may be used as a wavelength marker for the calibration. See col. 6, lines 7-19.

Independent claim 13 of the present application, as amended, recites a method for operating a microscope, comprising the steps:

- providing at least one transparent specimen support unit being associated with a specimen and a reference specimen, the reference specimen including at least one planar area having a defined structure of known configuration,
- detecting the reference specimen using light microscopy, and
- calibrating, aligning or adjusting the microscope on the basis of the detection.

It is respectfully submitted that Carter et al. does not teach or suggest providing a transparent specimen support associated with a reference specimen having at least one planar area having a defined structure of known configuration. Instead, Carter et al. merely teaches an “x-y sample stage 42,” which is not described as being transparent. See col. 6, lines 9-12. Also, the reference sample 90 of Carter et al. provides a wavelength marker useable to calibrate a spectrometer device, but does not include “at least one planar area having a defined structure of known configuration”, as recited in claim 13. Moreover, Carter et al. does not detect the reference specimen “using light microscopy”, as recited in claim 13. Rather, light from reference sample 90 is directed via mirror 46 through prism 52 and then via mirror 54 to photodetector array 58. See col. 6, lines 7-15, col. 3, lines 11-32, and Fig. 1. In fact, Carter

et al. has nothing to do with a microscope at all, and hence cannot provide "calibrating, aligning or adjusting the microscope", as recited in claim 13.

Withdrawal of the rejection of independent claim 13, as well as dependent claims 14, 21-25 and 27, under 35 U.S.C. §102 based on Carter et al., is respectfully requested.

Rejection under 35 U.S.C. §103(a) to claims 15-20 and 26

Claims 15-20 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carter et al. in view of EP 0491289.

EP 0491289 does not provide the features of claim 13 missing from Carter et al., discussed above. Therefore, a combination of the EP 0491289 with Carter et al., if proper, could not provide all the features of claim 13. Claims 15-20 and 26 properly depend from, and therefore include all of the limitations of independent claim 13. Because claim 13 is patentable over a combination of EP 0491289 with Carter et al., it is respectfully submitted that claims 15-20 and 26 are likewise patentable over such a combination.

Withdrawal of the rejection of claims 14-20 and 26 under 35 U.S.C. §103 (a) based on Carter et al. in view of EP 0491289 is respectfully requested.

New Claims 28-32

New claim 28 has been added to recite the "path length differences" recitation deleted from claim 26, as discussed above. New claims 29-32 have been added to recite features of the at least one planar area of the reference specimen which appear in withdrawn claims 6-9. Thus, new claims 29-32 find proper support in the present disclosure. It is respectfully submitted that no new matter has been added. New claims 28-32 properly depend from claim 13. It is respectfully submitted that new claims 28-32 are patentable over the Carter et al. and EP 0491289 references for at least the same reasons that claim 13 is patentable.

CONCLUSION

It is respectfully submitted that the application is now in condition for allowance.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By: 

William Gehris
Reg. No. 38,156

Davidson, Davidson & Kappel, LLC
485 Seventh Avenue, 14th Floor
New York, New York 10018
(212) 736-1940